



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/449,001      | 11/24/1999  | PAUL SENN            | BCK-201             | 5697             |

25181 7590 05/20/2004

FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

|          |
|----------|
| EXAMINER |
|----------|

TRAN, PABLO N

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2685

22

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/449,001

Applicant(s)

SENN ET AL.

Examiner

Pablo N Tran

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 2685

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 02/27/04 have been fully considered but they are not persuasive.

The Applicant's stated that "Kirby fails to teach or suggest "determining whether a prepaid platform is associated with a market for a MSC and modifying a subscriber profile based on whether a prepaid platform is associated with the market. In response to the Applicant, Kirby disclose a method and system that facilitate, translate, and exchange signaling to determine if a prepaid platform (see fig. 1/ no. 26, 46) is associated with a serving market (fig. 1/no. 20, 40, 60) and modifying a subscriber profile based on whether a prepaid platform is associated with the market (col. 26/ln. 1- col. 27/ln. 60).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2685

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-56 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kirby* (6,047,179).

As per claims 1, 12, 28, 33, 38, 43, and 51, *Kirby* disclosed a system for allowing a subscriber to a prepaid communication service to roam between a different service markets comprising: a serving MSC (fig. 1/no. 24, 44, and 64) capable of communicating with the subscriber's phone unit and capable of generating a request for a profile associated with the subscriber; a location register (fig. 1/no. 23, 43, and 63, col. 12/ln. 52-53) in communicating with the serving MSC and HLR (fig. 1/ln. 43) being

Art Unit: 2685

capable of collecting the subscriber profile and determined whether a prepaid platform (non-subscription/not-prepaid and subscription/prepaid) is associated with a market for the MSC (visited MSC or home MSC) and modifying the subscriber profile based on whether a prepaid platform is associated with the market for the MSC (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62); and a prepaid platform (fig. 1/no. 20 and 40) capable of performing call processing for a call associated with the subscriber.

As per claims 2 and 13, *Kirby* disclosed the location register includes a database having information representative of prepaid platforms associated with a plurality of markets capable of servicing the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 3 and 14, *Kirby* disclosed the location register includes a messaging processing unit for processing a message from the MSC to identify a prepaid platforms associated with the market for MSC (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 4 and 15, *Kirby* disclosed said MSC includes a profile request service capable of requesting a user profile to an NPA/NXX signal representative of the subscriber being a prepaid customer (TABLE A-F).

As per claims 5 and 16, *Kirby* disclosed the location register includes a memory space for storing information representative of a location associated with the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 6 and 17, *Kirby* disclosed the location register includes means for providing a HLR with information representative of a location associated with the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 7 and 18, *Kirby* disclosed the location register includes means for passing through registration requests for subscribers identified as not prepaid subscribers (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 8 and 19, *Kirby* disclosed the location register includes means for requesting subscriber location information from a HLR associated with the subscriber (col. 2/ln. 57-col. 3/ln. 20, col. 5/ln. 28-col. 7/ln. 14, col. 8/ln. 27-col. 9/ln. 40).

As per claim 9, *Kirby* disclosed the location register includes is in communication with the prepaid platform for delivering subscriber location information to the prepaid platform (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 10 and 20, *Kirby* disclosed the location register includes means for communicating with a VLR to allow call termination for a call (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claim 11, *Kirby* disclosed the location register includes an error reporter for reporting to detected error conditions to the prepaid platform (col. 18/ln. 44-col. 19/ln. 5).

As per claims 22 and 44, *Kirby* disclosed the call originates from at least one of a mobile telephone or a landline (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

Art Unit: 2685

As per claims 23, 29, 34, and 39-40, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to at least one of a prepaid platform located in the market associated with the MSC and a prepaid platform located in a market different than the market associated with the MSC (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 24, 30, 35, 47-48, and 53-54, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to at least one of a prepaid platform located in the market associated with the MSC for the MSC to complete the call (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 25, 27, 31, 36, 41, and 45, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to a hotline (toll-free) number on a PSTN (col. 18/ln. 44-col. 19/ln. 5).

As per claims 26, 32, 37, 42, 46, 49-50, 52, and 55-56 *Kirby* disclosed modifying the profile associated with the subscriber to include a hotline (toll-free) number for a prepaid platform located in a market different than the market for the MSC (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 18/ln. 44-col. 19/ln. 5, col. 24/ln. 29-col. 26/ln. 62).

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

**PABLO N. TRAN  
PRIMARY EXAMINER**



AV26 RF

May 17, 2004